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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/510,989

10/13/2004

Bruno Bret

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

HAND, MELANIE JO

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

02/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/510,989	Applicant(s) BRET ET AL.	
	Examiner MELANIE J. HAND	Art Unit 3761	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 14 January 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 32-41.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761

MJH

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed January 11, 2008 have been fully considered but they are not persuasive. With respect to arguments regarding the rejection of claims 32, 33 and 36-41 under 35 U.S.C. 103: Applicant argues that the present invention is directed to a paper substrate obtained by a dry method having a thermoplastic binder and antimicrobial agent and that the claimed invention is not suggested by Sine incorporating the Beerse and Thaman references. This is not persuasive for the following reasons: (1) Thaman teaches in Col. 3, lines 26 and 27 that the fibers of the substrate are wood pulp (i.e. paper) fibers, and teaches in Col. 3, lines 19-25, that the fibers are arranged into a web via a paper-making machine (i.e. the substrate is based on paper fibers and is of a non-woven type). The fact that the invention of Thaman is directed to a medicated cleansing pad is immaterial as Sine has incorporated the Thaman reference in its entirety. (see Sine, Col. 16, lines 36-51; (2) the limitation of "obtained by a dry method" constitutes product-by-process claim language given little patentable weight herein because the claims are directed to an article; (3) Thaman (incorporated by reference by Sine) teaches that the binder resin of the instant invention is a styrene-butadiene resin which is a synthetic latex, meeting the claim limitation of claim 35 which sets forth that the claimed thermoplastic binder is a synthetic latex and (4) Sine teaches in Col. 12, lines 12-16 that the antimicrobial agent is present in an amount between 0.05-0.5% by weight of the instant composition. The lower and upper limits of this range will necessarily be less than 0.05% and 0.5%, respectively, when the weight percentage of the antimicrobial agent is based upon the weight of the substrate, because the weight of the substrate plus composition will be greater than the weight of the composition alone. Thus the resulting range for weight percent of antimicrobial agent based upon weight of the substrate will overlap the range set forth in independent claim 32 of between 0.01-10% and the range set forth in claim 33 of 0.05-1%.

Applicant further argues that the essential component of Sine is an alcohol antiseptic in an amount of 40-99% and this component does not anticipate or render obvious the claimed essential component. This is not found persuasive. The fact that Sine or applicant considers the alcohol antiseptic the essential component in Sine's composition does not preclude the fact that the composition of Sine contains all of the components recited in claim 32 and teaches or fairly suggests all other limitations of claim 32. Since the composition of Sine by reference to Beerse and Thaman meets all of the limitations of claim 32 as to components of the claimed composition, Sine fairly suggests the claimed substrate.

Applicant further argues that the Sine reference may recite zinc gluconate, the zinc gluconate component is intended by Sine for use as an odor control component and not for imparting antimicrobial property to a substrate. This is not found persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further argues that Sine discloses in cols. 16 and 17 that the instant composition may also be incorporated into insoluble substrates and not to a substrate based on paper fibers of nonwoven type. This argument is not persuasive for reasons stated supra, specifically in reference to the incorporation of the Thaman reference by Sine, wherein the Thaman reference explicitly teaches a nonwoven paper substrate for use with the instant composition of Sine.

Applicant further argues that neither the Sine reference even with the incorporation of the Beerse and Thaman references does not disclose any quantity for the zinc gluconate sufficient to confer antimicrobial property to the paper substrate taught by Thaman. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the quantity of claimed antimicrobial agent to incorporated into the substrate to have in the final product an efficient quantity of zinc gluconate to enable the gluconate to have an antimicrobial effect per se) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant continues on, citing the Beerse document as support for their argument, which was never cited by Examiner in reference to zinc gluconate component quantity. Again, this quantity of zinc gluconate sufficient to confer antimicrobial property to the instant substrate is not recited in the claims and thus it is not required that the Beerse reference teach this quantity.

Applicant argues that the Beerse reference does not teach a quantity of composition to be incorporated into a substrate let alone a paper substrate based on fibers of a nonwoven type obtained by a dry method, etc. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Beerse reference is no a primary or secondary reference the grounds of rejection of claim 32, rather it is merely incorporated by Sine. Sine already addresses these limitations fully, as stated in detail supra.

Applicant further argues again that there is nothing in Sine or Beerse references that teaches or suggests any quantity for the zinc gluconate sufficient to confer antimicrobial property to the paper substrate taught by Thaman. This argument is addressed supra.

Applicant further argues that the antibacterial agent of Sine is an alcohol and not a metal gluconate. This is not found persuasive for reasons stated supra. With respect to arguments regarding the rejection of claim 36 under 35 U.S.C. 103: Applicants' arguments with regard to dependent claim 36 have been fully considered but are not persuasive as Applicants' arguments depend entirely on Applicants' arguments regarding the rejection of claim 32, which have been addressed supra.

